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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/720,463 | 11/24/2003 | Steven W. Smith | 0001-0005 | 4082 |
| 7590 | | 07/11/2005 | EXAMINER | |
| Steven W. Smith | | MAY, ROBERT J | | |
| 7237 Birchwood Drive | | ART UNIT | | |
| Dallas, TX 75240-3609 | | PAPER NUMBER | | |
| | | 2875 | | |

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,463

Applicant(s)

SMITH, STEVEN W.

Examiner

Robert May

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/24/2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 recites an electric motor that receives power from the AC power source Claim 6 recites an AC motor. The office fails to see the difference in scope between claims 1 and 6. Appropriate action is necessary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 6, 8-11, 13, & 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held (Swiss Pub. CH 673517) in view of Brumer (US Pat. 5,772,314).

In regard to Claims 1, 6, 8-11, 13, & 16, Held discloses all of the elements as claimed with the exception of an electric motor having a shaft extending through the front side of the casing proximate to the aperture illuminated by the light bulb. However, Brumer discloses in Fig. 3, a ceiling ornament system with an electric motor (48) and a rod (90) at which the cover rotates with while the motor (48) is turning the sheet assembly cover (12) relative to the lights (84). One would be motivated to combine the shaft and motor of Brumer with the nightlight of Held because the variable effect of light distribution or diffusion through the sheet assembly would be appreciated during rotation (Col. 3, Lines 55-56). Therefore, it would be obvious to one of ordinary skill in the art to combine the motor and shaft of Brumer to the nightlight of Held in order to enhance the variable light distribution that enhances the visual appeal.

Claims 2-5, 12, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Brumer as applied to claims 1, 6, 8-11, 13, & 16 above, and further in view of Bitting (US Pat. 4,491,772).

In regard to Claims 2-3, Held in view of Brumer discloses all of the elements of Claim 1, except for a switch that connects the AC power source to the light bulb independent of the electric motor, a second switch for connecting the AC power to the motor, and plurality of resistors between the light bulb and motor. However, Bitting

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discloses in Fig. 1, a control unit (105) for controlling a lighted ceiling fan, which has a switch for independently operating the light and a switch for connecting the AC power to the electric motor. One with ordinary skill in the art would be motivated to have the switches as disclosed in Bitting in order to have a non-variable light source or exclusively a light source with no rotation. Therefore, it would be obvious to one of ordinary skill in the art to combine the night light of Held and Brumer with the light switch and motor switch of Bitting in order to have night light that can be exclusively a non-variable light source.

In regard to Claims 4-5, 12, & 19 Bitting further discloses in Fig 2, a series of resistors (125 and R22-R27) between the lamp (100) and motor (120) and a potentiometer or rheostat (R40) for adjusting the speed or current to the motor (Col. 8, Lines 55-58) in order to change the speed of the fan to suit one's comfort level. It is generally known by one of ordinary skill that resistors regulate power by resisting the flow of current. Therefore, it would be obvious to one of ordinary skill to use a series of resistors and potentiometer as disclosed in Bitting with the night light disclosed in Held and Brumer in order to respectively balance or adjust the flow of current between the lamp and motor as well as have a potentiometer to adjust the speed at which disc rotates to better suit one's level of comfort.

Claims 14-15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Brumer as applied to claims 1, 6, 8-11, 13, & 16 above, and further in view of Boyle (US Pat. 6,592,423). Held in view of Brumer disclose all of the elements

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as disclosed in Claim 13, except for a means for energizing which is a battery and the rotating means is a DC motor. However, Boyle discloses in Figure 2, batteries (50A & 50B) and a dc motor (26) as an energizing means for rotating and illuminating a holographic toy in order to make the toy portable. Therefore it would be obvious to combine the batteries and motor of Boyle with the night light of Held and Brumer because it can make the device portable.

Claims 7 & 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Brumer and Boyle as applied to claims 14-15 above, and further in view of Wang (US Pat. 6,513,951). While Held in view of Brumer and Boyle disclose all of the elements as claimed in Claims 14-15, they fail to explicitly disclose an AC/DC converter. However, Wang in Figure 5(a) discloses an AC/DC adaptor or converter (52) in order to run the apparatus off of AC power and convert the AC current to DC current. It is generally known to one of ordinary skill that if one wished to make the device portable and to run off a conventional dc power source such as a battery instead of using a standard AC wall outlet source, that one would be motivated to use a dc motor and it would be obvious to use an AC/DC converter. Therefore, it would be obvious to one of ordinary skill in the art to use the AC/DC converter of Wang with a DC motor with the nightlight of Held, Brumer and Boyle because it would provide a means for using the nightlight in a portable manner.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mizutani (US Pat. 4,073,598) and Laurel (US Pat. 4,402,649) disclose a ceiling fan with light and switch for independent operation of the light and motor speed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert May whose telephone number is (571) 272-5919. The examiner can normally be reached between 9 am– 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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